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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,656	01/30/2002	Yoshihisa Tsukada	0649-0821P-SP	3874

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EXAMINER

CHEA, THORL

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 01/02/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

10/058,656

Applicant(s)

TSUKADA ET AL.

Examiner

Thorl Chea

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is unclear whether the compound that satisfied at least one of the conditions (A) and (B) is considered as component of reducing agent or the compound that compound that satisfies at least one of the conditions (A) and (B) is in the material, but not act as reducing agent. Note to the language "wherein the reducing agent contains: a phenol compound; and a compound that satisfies at least one of the conditions (A) and (B):..." The claiming of "compound that satisfies at least one of the conditions (A) and (B)" is indefinite for failing to included the conditions (A) and (B) therein.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-13, 15-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kato ('663).

See Kato in column 24, example 4 to column 28 wherein the material contains photosensitive silver halide, non-photosensitive organic silver salt, reducing agent and polymer latex contains in the undercoat layer in column 25 and image forming layer in column 27; the reducing agent such as 1,1-bis (2hydroxy-3,5-dimethyl-phenyl-3,5,5-trimethyl hexane in column 25, lines 25-30; the preferred reducing agent having at least phenolic hydroxyl group in column 10, lines 41-45; the high contrast accelerator such as amine derivative, disulfide derivatives, hydroxylamine in column 11, lines 17-20 and the compound having phosphoryl containing group in table 3 in column 28.

Kato discloses the use of the polymer latex as binder in the undercoat layer and in the imaging layer. Kato does not disclose whether the halogen ion contained in the latex, and therefore, it is assumed that the latex taught therein contains no halogen ion content therein. Since the scope of "polymer latex has halogen ion content of not more than 500 ppm" include 0.0 ppm, it is asserted that the scope of latex claimed in the present claimed invention and that taught in Kato is similar. Accordingly, the claimed invention lacks novelty. Alternatively, it would have obvious to the worker of ordinary

Art Unit: 1752

skill in the art to use any type of binder taught therein to provide the invention as claimed.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato as applied to claims 1-13, 15-17 above, and further in view of Milton et al (Milton). The compound taught in claim 14 is taught in Milton in column 2 as antifoggant for silver halide material. It would have been obvious to use the compound taught in Milton to improve the antifogging property caused by silver halide in the material of kato to provide the invention as claimed.

7. Claims 1-6, 9-10, 15-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP0803764 (EP'764).

EP'764 discloses a heat developable photosensitive material having composition as claimed, which is a support, a photosensitive silver halide, a non-photosensitive organic silver salt, reducing agent including polymer latex. Note for instance the inventive samples Table 8, samples 104-17, page 31; in Table 9, samples 210-213 on page 40; the film forming temperature about -30 to 90 °C or more on page 3; the polymer latex described on page 4; the reducing agent containing a phosphoryl group on page 12, compound R-I-51. EP'764 does not disclose whether the halogen ion contained in the latex, and therefore, it is assumed that the latex taught therein contains no halogen ion content therein. Since the scope of "polymer latex has halogen ion content of not more than 500 ppm" include 0.0 ppm, it is asserted that the scope of latex claimed in the present claimed invention and that taught in EP'764 is similar. Accordingly, the claimed invention lacks novelty. Alternatively, it would have obvious to the worker of ordinary

Art Unit: 1752

skill in the art to use any type of binder taught therein to provide the invention as claimed.

8. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Patent Abstract of Japan, Publication No. 2000-010229 (JP'229)

See abstract of the JP'229 wherein the polymer latex contains less than 600 ppm of ammonium ion, and sodium ion. This latex contains zero amount of halogen ion, which is read on "not more than 500 ppm of halogen ion content" claimed in the present claimed invention. Accordingly, the claimed invention lacks novelty.

9. Claims 1-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP0911691 (EP'691).

EP'691 discloses a photothermographic material containing polymer latex which has been treated with a separation fractional polymer or has an ionic conductivity of up to 2,5 mS/cm. Note to the material on page 29, claims 1-12. Since the polymer latex has been treated before the use thereof in the heat developable material, the material that would affect the property of the photothermographic material would be reduced. Note for instance on page 3 last paragraph, it is disclosed that "a polymer latex is treated with a separation functional polymer as by ultrafiltration is usually carried out plural time", and "is reduced ionic conductivity". Therefore, it asserted that the polymer latex taught in the EP'691 is more purified and the ionic group such as halogen ion would be reduced to very small amount included the halogen ion presented in the claimed invention, and the invention as claimed would be either anticipated or found obvious over EP'691 in the absence of showing otherwise.

Art Unit: 1752

10. Claims 7-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP0911691 (EP'691).as applied to claims 1-6 above, and further in view of Kato ('663), Harring et al ('449) and EP0803764 (EP'764).

Kato discloses a compound having a phosphoryl group in its molecule and the amine derivative as high contrast accelerator (abstract, and column 11, lines 17-20); Harring in column 16, lines 51-68, and columns 17-18 disclosed hydrogen donor as contrast enhancing compound; Milton in column 2 discloses a phosphoryl compound as antifoggant for silver halide material; EP'764 on page 12 a phenolic reducing agent of formula (I) of claim 9, including the compound having a phosphoryl group its molecule as reducing agent. it would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use a known reducing agent and the high contrast enhancer taught in Kao, Harring, Milton and EP'764 in the material of EP'691 with an expectation of achieving a material producing low fog, stable during storage and high image contrast.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.


Art Unit: 1752

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea   
December 27, 2002

  
Thorl Chea  
Primary Examiner  
Art Unit 1752